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THE STATES OF AME			WWW.tispic-Box		
		THE PARTITION	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	9319S-000328	3300	
10/072,658	02/07/2002	Tomoyuki Furuhata	93173-00022		
27572 7:	590 06/19/2003		EXAMINER		
n a day 828	DICKEY & PIERCE,	P.L.C.	PIZARRO CRESPO, MARCOS D		
BLOOMFIELI	D HILLS, MI 48303		ART UNIT	PAPER NUMBER	
			2814		
			DATE MAILED: 06/19/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

• •		Application No			pplicant(s)	
•		10/072,658		F	URUHATA ET	AL.
	Office Action Summary	Examiner			Art Unit	
		Marcos D. Piza	ro-Cres		2814	nddross
	The MAILING DATE of this communication app	pears on the cove	r sheet	t with the cor	responaence a	auuress
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THE M - Extens after S - If the p - If NO - Failure - Any re earner	PREPLY STATUTORY PERIOD FOR REPLIALING DATE OF THIS COMMUNICATION. IN (6) MONTHS from the mailing date of this communication. In (7) MONTHS from the mailing date of this communication. In (8) MONTHS from the mailing date of this communication. In (9) Period for reply specified above is less than thirty (30) days, a repreperiod for reply is specified above, the maximum statutory period is to reply within the set or extended for reply will, by statutingly received by the Office later than three months after the mailing displayed the mailing of the patent term adjustment. See 37 CFR 1.704(b).	136(a). In no event, ho bly within the statutory n will apply and will expi	vever, ma inimum of e SIX (6) I	ay a reply be timel of thirty (30) days v MONTHS from th	ly filed will be considered ting the mailing date of thi (35.11.S.C. § 133).	mely. s communication.
Status	Responsive to communication(s) filed on 27	May 2003 .				
1)⊠	2b/⊠ T	this action is non	-final.			
2a) ☐ 3) ☐ Dispositi	Since this application is in condition for allow closed in accordance with the practice unde ton of Claims	, LA Paris III	formal e, 1935	I matters, pro 5 C.D. 11, 4	osecution as to 53 O.G. 213.	o the ments is
4)⊠	Claim(s) 1-18 is/are pending in the application	on.	. aansi	ideration		
	4a) Of the above claim(s) <u>1-7 and 12-18</u> is/ar	re withdrawn from	II COIISI	ideration.		
5)[]	Claim(s) is/are allowed.					
6)⊠	Claim(s) <u>8-11</u> is/are rejected.					
7 \[\]	Claim(s) is/are objected to.		4			
8)⊠	Claim(s) <u>1-18</u> are subject to restriction and/o	or election requir	ement.	•		
Applicat	tion Papers					
9)⊠	The specification is objected to by the Exami	iner.	iocted t	to by the Exa	miner.	
10)[The specification is objected to by the Detailed The drawing(s) filed on is/are: a) ac Applicant may not request that any objection to	ccepted of b) of	held in	abevance.	See 37 CFR 1.8	5(a).
	Applicant may not request that any objection to The proposed drawing correction filed on	is: a)∏ apo	roved t	b)∐ disappr	oved by the Ex	aminer.
11)□	The proposed drawing correction filed on	is. u) app or reply to this Office	e action	n.		
	If approved, corrected drawings are required in	Fyaminer.				
	The oath or declaration is objected to by the	, when the second				
Priority	under 35 U.S.C. §§ 119 and 120	roian priority und	er 35 U	J.S.C. § 119	(a)-(d) or (f).	
13)[Acknowledgment is made of a claim for for	eign priority and	.,	 U		
	a) ☐ All b) ☐ Some * c) ☐ None of:	nonte have heen	receive	red.		
	1.☐ Certified copies of the priority docum	nonte have been	receive	ed in Applica	ation No	<u> </u>
	 1. Certified copies of the priority documents have been received in Application No 2. Certified copies of the priority documents have been received in this National Stage 3. Copies of the certified copies of the priority documents have been received in this National Stage 3. Copies of the certified copies of the priority documents have been received in this National Stage 					
	application from the internations	list of the certifi	ed copi	ies not recei	ved.	
14)	The standard of a claim for dor	nestic priority un	ger 35	0.3.0. 8 11	0(0) (10 % [11]	isional application)
	Acknowledgment is made of a stain term a)					
Attachr						aper No(s)
1) 🛛 !	Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-94 Information Disclosure Statement(s) (PTO-1449) Paper N	18) No(s)	5) 🔲 1	Interview Sumn Notice of Inform Other:	nal Patent Applica	tion (PTO-152)
		Sine Action Summa			Part of Par	per No. 11

Application/Control Number: 10/072,658 (Non-Final Rejection)

Art Unit: 2814

Attorney's Docket Number: 9319S-000328

Filing Date: 2/7/2002

Claimed Foreign Priority Date: 1/30/2002 (JP 2002-21025)

2/8/2001 (JP 2001-32069)

Applicant(s): Furuhata et al.

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the election in paper no. 10 filed on 5/27/2003.

Election/Restrictions

- Applicant's election without traverse of claims 8-11 in paper no. 10 is 1. acknowledged.
- Claims 1-7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) 2. as being drawn to a nonelected species, there being no allowable generic or linking claim.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which 3. papers have been placed of record in the file.

Specification

The title of the invention is not descriptive. A new title is required that is clearly 4. indicative of the invention to which the claims are directed.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 7. Initially, and with respect to claim 11, note that a "product-by-process" claim is directed to the product per se, no matter how actually made. See <u>In re Thorpe et al.</u>, 227 USPQ 964 (CAFC, 1985) and the related case law cited therein which makes it clear that it is the final product *per se* which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. As stated in Thorpe,

even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir. 1935).

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Note that Applicant has burden of proof in such cases, as the above case law makes clear.

- 8. Claims 8-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Kim (GB 2305295).
- 9. Regarding claim 8, Kim shows (see, e.g., fig. 2) all aspects of the instant invention including a semiconductor device having a non-volatile memory transistor formed on a semiconductor layer 101, the device comprising an interdielectric layer provided over the semiconductor layer 101 and the transistor. The interdielectric layer includes an oxide film 121 provided as a lowermost layer and a layer containing nitride (not shown) provided on the oxide film 121.
- 10. Regarding claim 9, Kim shows that the oxide film **121** may have a thickness of 30-70 nm (see, *e.g.*, pp.6/II.15-20).
- 11. Regarding claim 11, Kim shows that the interdielectric layer includes an oxide film **121** (see, e.g., fig. 2).

As to the grounds of rejection under section 103(a), the method of forming the oxide film by reduced pressure CVD using TEOS, is an intermediate process step that does not affect the structure of the final device. See MPEP § 2113, which discusses the handling of "product by process" claims and recommends the alternative (§ 102 / § 103) grounds of rejection.

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Conclusion

12. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center located in Crystal Plaza 4, room 3C23. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is (703) 308-7722 or -7724. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos D. Pizarro-Crespo at (703) 308-6558 and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (703) 308-4918.

14. Any inquiry of a general nature or relating to the status of this application should be directed to the **Group 2800 Receptionist** at **(703) 308-0956**.

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15. The following list is the Examiner's field of search for the present Office Action:

	ield of Search	Date
U.S. Class / Subclass(es)		6/5/2003
Other Documentation:	PLUS Analysis	6/5/2003
Electronic Database(s):	EAST (USPAT, EPO, JPO, PGPub)	6/5/2003

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